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FEB 28 2005

OFFICE OF PETITIONS

In re Application of
Douglas J. Cudney et al.
Application No. 10/665,601
Filed: September 22, 2003
Attorney Docket No. 3156-0119P

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(b)
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This decision is in response to the request for reconsideration filed February 17, 2005, under 37 CFR 1.47(a), in response to the decision mailed January 28, 2005, dismissing the petition filed March 16, 2004. In view of the facts submitted with the request, the petition is treated under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on September 22, 2003 as a continuation of parent application 09/335,897 and naming Douglas J. Cudney and Karen Breitbach as joint inventors. The oath or declaration submitted upon application was executed by David H. Anderson as the CEO of the assignee and on behalf of the non-signing inventors. Mr. Anderson's signature appeared in the space provided for a third named inventor and thus the office records have treated him as such. The decision mailed January 28, 2005 indicated that since some of the named inventors signed the oath or declaration and one or more of the named inventors had not signed the declaration, the petition needed to be treated under 37 CFR 1.47(a). Since inventorship was incorrectly stated but now clarified, there is no need to treat this petition as if any of the inventors had executed the oath or declaration. There is also no need for a separate petition to correct the inventorship since a proper oath or declaration has not been provided. Mr. Anderson will be removed from office records as an inventor.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the

oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

With respect to the remaining requirements under 37 CFR 1.47(b), however, the petition still lacks item (1) and now in light of the additional evidence submitted with the instant request for reconsideration, also lacks item (2).

Petitioners seek status under 37 CFR 1.47 based on the fact that the declaration was sent to Mr. Cudney's and Ms. Breitbach's last known address and based on the fact that both Mr. Cudney and Ms. Breitbach verbally refused to sign the declaration, in spite of efforts to have the oath or declaration executed.

In regards to item (1), petitioners have still not provided sufficient proof that a copy of the instant application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventors. As was indicated in the decision mailed January 28, 2005, dismissing the petition, the declaration by Nancy Page regarding efforts to reach Mr. Cudney and Ms. Breitbach, reveals that the declaration was sent to them, but doesn't indicate that the complete application was ever sent to them. Thus, there is still no evidence to show that the non-signing inventors had the benefit of reviewing the application. Petitioners have suggested that the fact that the joint inventors had reviewed the parent application, 09/335,897 filed June 18, 1999, was tantamount to them having reviewed the application in the instant application and thus credible evidence in support of their argument.

Likewise, in regards to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented.

The oath or declaration submitted by petitioners on March 16, 2004 is defective because, as indicated above, it is executed by David H. Anderson and lists him as a third inventor. The oath or declaration submitted with the instant request for reconsideration is the oath or declaration filed with the parent application. However, that oath or declaration is defective because Mr. Cudney's citizenship, post office and residence addresses were omitted and because Ms. Breitbach's post office address had been omitted. Petitioner offers an application data sheet ("ADS") to correct the post office and residence addresses for Mr. Cudney and Ms. Breitbach and argues that with the "ADS", the oath or declaration submitted together with the parent application satisfies the requirement under 37 CFR 1.63.

Petitioner's arguments have been considered but are not persuasive. The parent application is irrelevant in this instance since the oath or declaration in that matter was defective. Submission of the "ADS" by itself does not cure the defect. For your convenience, please refer to PTO form SB/01 which is a Declaration (37 CFR 1.63) for a Utility or Design Application when an Application Data Sheet (37 CFR 1.76) is used.

Since the oath or declaration from the parent application is not acceptable for purposes of satisfying requirement (2) it is also unacceptable in furtherance of requirement (1) and the argument that the non-signing inventors had reviewed the application of the parent and thus the application of the continuation application. If the oath or declaration in the parent application had not been defective, petitioners could have submitted the oath or declaration without the need for a petition under 37 CFR 1.47 as the reviewed and understood clause from the parent would have been imputed to the continuation application.

In view of the above, petitioners must show that the non-signing inventors have had an opportunity to view the instant application and, may show proof that a copy of the application was sent, or given to the non-signing inventors for review, by providing a copy of the cover letter transmitting the application papers to the non-signing inventors, or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

A declaration in compliance with 37 CFR 1.63, 1.64, and 1.67 must be presented, signed by all of the signing inventors, if any. If no inventor(s) will sign the declaration, the declaration may be signed on behalf of the inventor by an assignee. The oath or declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration, as well as his/her mailing address, residence, if the applicant lives at a different location from where he or she customarily receives mail, as well as the citizenship of individual signing on behalf of the non-signing inventor. If the oath or declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be

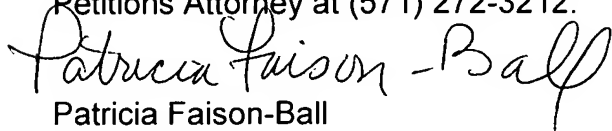
submitted.¹

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned
Petitions Attorney at (571) 272-3212.

A handwritten signature in cursive script that reads "Patricia Faison-Ball". The signature is written in black ink and is positioned to the left of the printed name.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

¹MPEP 409.03 (b) .